



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,075	06/06/2001	Hiroshi Endo	9976-9US (OB0025US)	6219

570 7590 08/28/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
2152	

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/875,075	Applicant(s) ENDO, HIROSHI	
	Examiner Victor Lesniewski	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-36 is/are rejected.
- 7) ☒ Claim(s) 35 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 6/13/2006 has been placed of record in the file.
2. Claims 1, 2, 4-14, and 16-28 have been canceled.
3. Claims 29-36 have been added.
4. Claims 29-36 are now pending.
5. The applicant's arguments with respect to claims 29-36 have been considered but are moot in view of the following new grounds of rejection.

Response to Amendment

6. All claims now pending are new. The new independent claims represent a change in scope as they include limitations not previously presented.

Claim Objections

7. Claims 35 and 36 are objected to because of the following informalities:
 - Claim 35 states “the second category of telephone numbers” at lines 14-15. In accordance with the applicant’s specification and other claims, it appears as though this is a typographical error and should be “the first category.” For the purpose of applying prior art it will be assumed that claim 35 states “the first category of telephone numbers” at lines 14-15.
 - Claim 36 makes claim to “the image communication method according to Claim 34.” However claim 34 does not recite a method and therefore claim 36 cannot be dependent on it. For the purpose of applying prior art it will be assumed that claim 36 refers to the

method of transmitting images according to Claim 35.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 29-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiyama et al. (U.S. Patent Number 6,674,541), hereinafter referred to as Kamiyama, in view of Thornton et al. (U.S. Patent Number 6,363,065), hereinafter referred to as Thornton.

10. Kamiyama disclosed a method for transmitting facsimile data between facsimile devices via an Internet protocol network that uses IP addresses corresponding to telephone numbers of the facsimile devices. In an analogous art, Thornton disclosed a network communication system with improved telephony gateways for automatically routing telephone calls (voice, data, facsimile, etc.) over a data network.

11. Concerning claims 29 and 35, Kamiyama did not explicitly state two separate categories of telephone numbers. Since Kamiyama does teach an address translation table, it would be a clear extension of his system to provide a separate table with the same functionality for any separate category of telephone numbers. Furthermore, Thornton does explicitly disclose two separate categories of telephone numbers and two separate tables for storing the data as his system utilizes an internal routing table and an external routing table. It would have been

obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Kamiyama by adding the ability to utilize two separate categories of telephone numbers as provided by Thornton. Here the combination satisfies the need for a system that transmits facsimile data between facsimile apparatuses which can improve transmission quality of the facsimile data on an IP network. See Kamiyama, column 1, lines 40-47. This rationale also applies to those dependent claims utilizing the same combination.

12. Concerning claim 33, Kamiyama did not explicitly state storing the address translation table in the facsimile device or moving the functionality of address translation from the gateway to the facsimile device. However, the distribution of network services in a communications network was well known in the art at the time of the applicant's invention. It was known that various services or processes could be accomplished by various devices in the network or distributed across various devices in the network without changing the overall functionality or purpose of the network itself. Thus, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Kamiyama by storing the address translation table in the facsimile device or by otherwise moving the functionality of address translation from the gateway to the facsimile device.

13. Thereby, the combination of Kamiyama and Thornton discloses:

- <Claim 29>

An image communication system comprising: a plurality of image communications apparatuses, each of which possessing a telephone number belonging to a first category of telephone numbers, a telephone number belonging to a second category of telephone numbers and a corresponding network address (Kamiyama, figure 1, items 1-31, 1-32, 1-

41, 1-42); a first address supplying device storing telephone numbers belonging to the first category of telephone numbers, the corresponding network address of each one of the plurality of image communications apparatuses and a relationship between each one of the telephone numbers belonging to the first category of telephone numbers and each one of the corresponding network addresses (Kamiyama, figure 1, item 1-4 and column 5, lines 20-23, and Thornton, column 35, lines 56-63); a second address supplying device storing telephone numbers belonging to the second category of telephone numbers, the corresponding network address of each one of the plurality of image communications apparatuses and a relationship between each one of the telephone numbers belonging to the second category of telephone numbers and each one of the corresponding network addresses (Kamiyama, figure 1, item 1-4 and column 5, lines 20-23, and Thornton, column 35, lines 56-63); and a judging section included in each of the plurality image communications apparatuses, said judging section included in one of the plurality of image communications apparatuses determining whether a telephone number input to the one of the plurality of image communications apparatuses belongs to the first category of telephone numbers or to the second category of telephone numbers, and directing the input telephone number to the first address supplying device or to the second address supplying device based on the determination (Thornton, column 30, line 44 through column 31, line 7), said first or said second address supplying device providing the corresponding network address of the input telephone number to the one of the plurality of image communication apparatuses (Kamiyama, column 2, lines 34-43).

- <Claim 30>

The image communication system of claim 29, wherein each of the plurality of image communications apparatuses, the first address supplying device and the second address supplying device are operably connected together by a computer network (Kamiyama, figure 1).

- <Claim 31>

The image communications system of claim 29, wherein each of the plurality of image communications apparatuses are connected to an outside telephone network and possess an outside telephone number for communication therethrough (Thornton, column 16, lines 60-67).

- <Claim 32>

The image communications system of claim 29, wherein each of the plurality of image communications apparatuses are connected to an inside telephone network and possess an inside telephone number for communication therethrough (Thornton, column 16, lines 47-59).

- <Claim 33>

The image communications system of claim 29, wherein the function of at least one of the first address supplying device and the second address supplying device is incorporated in at least one of the plurality of image communications apparatuses (obviousness as discussed in paragraph 12 above).

- <Claim 34>

The image communications system of claim 29, wherein the first category of telephone numbers corresponds to a outside telephone numbers and the second category of telephone numbers corresponds to inside telephone numbers (Thornton, column 35, lines 56-63).

- <Claim 35>

A method of transmitting images between a plurality of image communications apparatuses, each of the plurality of image communications apparatuses possessing a telephone number belonging to a first category of telephone numbers, a telephone number belonging to a second category of telephone numbers and a corresponding network address (Kamiyama, figure 1, items 1-31, 1-32, 1-41, 1-42), the method comprising the steps of: receiving in a first one of the plurality communication apparatuses a telephone number of a second one of the plurality of image communication apparatuses (Kamiyama, column 2, lines 34-43); judging whether said received telephone number corresponds to the first category of telephone numbers or to the second category of telephone numbers (Thornton, column 30, line 44 through column 31, line 7); attempting to acquire the network address corresponding to the telephone number of the second one of the image communication apparatuses if said telephone number is determined to belong to the first category of telephone numbers by referring to a first table storing the corresponding network address of each one of the plurality of image communications apparatuses and a relationship between each one of the telephone numbers belonging to the second category of telephone numbers and each one of the

corresponding network addresses (Kamiyama, figure 1, item 1-4 and column 5, lines 20-23, and Thornton, column 35, lines 56-63); attempting to acquire the network address corresponding to the telephone number of the second one of the image communication apparatuses if said telephone number is determined to belong to the second category of telephone numbers by referring to a second table storing the corresponding network address of each one of the plurality of image communications apparatuses and a relationship between each one of the telephone numbers belonging to the second category of telephone numbers and each one of the corresponding network addresses (Kamiyama, figure 1, item 1-4 and column 5, lines 20-23, and Thornton, column 35, lines 56-63); and transmitting said image to said second image communication apparatus via the computer network the based on the acquired network address if the network address is acquired (Kamiyama, abstract).

- <Claim 36>

The image communication method according to Claim 34, further comprising the step of: transmitting said image from said first image communication apparatus to said second image communication apparatus through one of a first telephone network and a second telephone network if said network address is not acquired (Thornton, column 6, line 61 through column 7, line 6).

Since the combination of Kamiyama and Thornton discloses all of the above limitations, claims 29-36 are rejected.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Feder (U.S. Patent Number 5,872,845) disclosed a method for implementing facsimile transmission over data networks.
- White et al. (U.S. Patent Number 6,014,379) disclosed a method for call set up in which a domain name address may be used to establish a link through the Internet between the calling and called stations.
- Freeman (U.S. Patent Number 6,020,980) disclosed a method for delivering facsimile messages to email addresses as object files attached to or inserted within email messages.
- Yoshida et al. (U.S. Patent Number 6,801,546) disclosed a method of communication between facsimile machines that uses the assignment of relay destinations to transmit data over an IP network.

15. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2152

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.

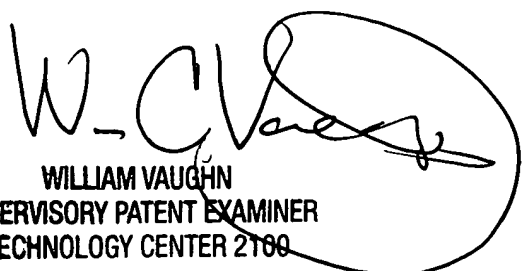
The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor Lesniewski
Patent Examiner
Group Art Unit 2152



WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100